

REMARKS

Claims 44 and 46-49 are active. Independent claim 46 has been amended to include the limitations of claim 47. Claim 45 has been made to depend from claim 46. Dependent claim 45 has been edited to address a description and indefiniteness rejection pertaining to the term “contiguous”. The word “contiguous” means the eight or more amino acids are adjoining and next to each other. It is a clarifying term and doesn’t introduce a new concept since fragments of adjoining nucleotides of this length sequences are disclosed on lines 17-18 at page 10 of the specification. If the Examiner believes the term “contiguous” is superfluous, then it can be omitted from these claims. New claims 48 and 49 depend from claim 46 and separately claim methods based on either SEQ ID NO: 1 or 2 as previously described by claim 45. No new matter is believed to have been introduced. The Applicants respectfully request that this after-final Amendment be entered by the Examiner to place this application in condition for allowance or in better condition for appeal. The proposed amendments do not raise new issues or necessitate a new search by the Examiner, since the amendment is based on elements earlier claimed or inherent in the previously examined claims. Entry of this Amendment would also permit the Applicants to respond to new arguments raised in the final rejection.

Restriction/Election

The Applicants previously elected with traverse **Group I**, claims 1-6, 37 and 45, directed to a method of identifying ligands or aptamers. The requirement has been made FINAL.

Rejection—35 U.S.C. §112, first paragraph

Claims 2 and 45 were rejected under 35 U.S.C. 112, first paragraph, as lacking adequate descriptive support. This rejection is moot in view of the cancellation of claim 2 and the amendment of claim 45 to clarify the phrase containing “contiguous”.

Rejection—35 U.S.C. §112, first paragraph

Claims 1-6, 37, and 45-47 were rejected under 35 U.S.C. 112, first paragraph, as lacking adequate descriptive support. This rejection is moot in view of the cancellation of claims 1-6, 37 and 47, in view of the amendment of claims 45 and 46 and in view of the Applicants prior remarks. At the time of invention it was well within the skill of the art to select an adequate starting mixture of nucleic acids for performing an aptamer selection according to the systematic evolution of ligands by exponential enrichment (SELEX) method dating back to 1990. It should be appreciated that the starting mixture need not be enriched in particular sequences and that SEQ ID NO: 1 and 2 only relate to the primer sequences necessary to perform the RT-PCR enriching steps (see Example 1). Any other primer sequences could be used. Thus, the limitations of claim 45 have not been included as essential in independent claim 46.

Rejection—35 U.S.C. §112, second paragraph

Claims 2 and 45-47 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is moot in view of the cancellation of claims 2 and 47 and in view of the amendment of claims 45 and 46. The phrase “at least 8 contiguous nucleotides” in claim 45 refers to fragments that are subsequences of SEQ ID NO: 1 or 2 that have at least eight nucleotides from these sequences in a row.

Rejection—35 U.S.C. §103(a)

Claims 1-6, 37 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chen, PNAS 10:9226 in view of Yayon, et al., U.S. Patent No. 7,498,416. This rejection is moot in view of the cancellation of claims 1-6 and 37 and the amendment of claim 45 to depend from claim 46, which was not rejected.

Conclusion

In view of the amendments and remarks above, the Applicants respectfully submit that this application is now in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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